UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/401,875	09/23/1999	ABRAHAM I. ZEIGLER	09857/023001	5266

26161 7590 04/04/2011
FISH & RICHARDSON P.C. (BO)
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER	
CAMPEN, KELLY SCAGGS	
ART UNIT	PAPER NUMBER
3691	

NOTIFICATION DATE	DELIVERY MODE
04/04/2011	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ABRAHAM I. ZEIGLER,
RICHARD G. KETCHUM, and
ALFRED R. BERKELEY III

Appeal 2009-007849
Application 09/401,875
Technology Center 3600

Before HUBERT C. LORIN, JEAN R. HOMERE, and
BIBHU R. MOHANTY, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

STATEMENT OF THE CASE[1]

Abraham I. Zeigler et al. (Appellants) filed a Request for Rehearing of the Decision. The Board had reversed the Examiner's § 112, second

---

[1] Our decision will make reference to the Appellants' Request for Rehearing (filed Sep. 21, 2010, "Request") and the BPAI Decision (mailed Jul. 26, 2010, "Decision").

paragraph, rejection of claims 1-23 but affirmed the Examiner's §102(b) rejection of claims 1-23 as anticipated by Gutterman (WO 91/14231).

In accordance with 37 C.F.R. §41.52(a)(1), the Request includes certain points, in particular, that the Appellants believe the Board misapprehended or overlooked in reaching its Decision.

The challenge to the Board's decision to affirm the §102(b) rejection centers on the claim 1 limitation "receiving by the server computer system from client systems .. additional aggregate quotes ... being quotes that are displayable on displays of client systems, as trading interest in a security, but not being attributable to any market participant." Request 2. The Board took the view that this limitation reads on Gutterman because "Gutterman describes a computer system that receives information and displays it" (Decision 5). The Board went on to address the Appellants' argument that "Gutterman does not describe the claim limitations 'aggregate quotes' and 'displayable ... as trading interest in a security, but are not attributable to any market participant' as claimed" (Decision 5), finding

> [t]hat "aggregate quotes" refer to a content of information [which] is evidenced by the fact that the Specification exemplifies an aggregate quote as a number (*see* p. 9, ll. 12-29, *e.g.*, "3,000"). In our view, such an alleged distinction - that the Appellants have drawn their claimed invention to "aggregate quotes" and not to some other type information - is not patentably consequential. It is a distinction based on the descriptive material being received and displayed.

Decision 5-6. The Appellants dispute that the claim limitations "aggregate quotes" and "displayable ... as trading interest in a security, but are not attributable to any market participant" are nonfunctional descriptive material. Request 1-6.

We have reviewed the Request in its entirety but do not find that the Appellants have shown the Board to be in error. Our reasons are enumerated in the DISCUSSION section below.

DISCUSSION

Claim 1

First, the Appellants argue that the Board "improperly ignored" the claim 1 limitation "receiving by the server computer system from client systems .. additional aggregate quotes ... being quotes that are displayable on displays of client systems, as trading interest in a security, but not being attributable to any market participant." Request 3. This is incorrect. The Board addressed it. *See supra*.

Second, the Appellants criticize the Board for changing the facts by relying on an additional factual finding - e.g., aggregate quotes are nonfunctional descriptive material - that was not raised by the Examiner. Request 4. That is not a persuasive argument as to error in the Board decision. The debate during prosecution between the Appellants and the Examiner focused almost entirely on the type of information the claimed invention uses. The Examiner took the view that, while Gutterman did not disclose the claim terms "aggregate quote" and "quote," "the various terms used by Gutterman for example futures prices stock options prices etc. are within the scope of appellants use of the term 'quotes.'" Answer 10. The Appellants took the position that "[a]pparently the examiner cannot find those features in Gutterman" (Reply Br. 2), because, apparently, "that type of quote did not exist prior to Appellants use of the quote" (Reply Br. 2, footnote 3). Accordingly, it is quite clear that the issue was whether

Gutterman described the "type" of information used in the claimed invention. The facts have not changed. The Board did not add an additional fact. Rather, consistent with the law on claim construction, the Board characterized the argued-over distinction between the type of information the claimed invention uses and that of Gutterman as a "distinction based on the descriptive material being received and displayed" (Decision 6).

Third, the Appellants do not agree that the claim limitation "additional aggregate quotes ... being quotes that are displayable on displays of client systems, as trading interest in a security, but not being attributable to any market participant" is directed to nonfunctional descriptive material and, thus, argue that the decisions the Board relied upon (*see* Decision 6) are inapposite. Request 3-6. We do not find the argument persuasive as to error in the rejection. There appears to be no dispute that the quotes as claimed are a "type" of information which, according to claim 1, are received by a server computer and displayable on displays of client systems. We fail to understand in what way the server computer and displays are functionally affected by this "type" of information. We stated "[t]hat 'aggregate quotes' refer to a content of information is evidenced by the fact that the Specification exemplifies an aggregate quote as a number (*see* p. 9, ll. 12-29, *e.g.*, "3,000")." Decision 5. This has not been disputed. In light of what the Specification discloses, broadly construing the claim limitation "aggregate quotes" as informational content that is nonfunctional and descriptive is reasonable. In what way is the server computer as claimed functionally affected by receiving the number 3000? In what way are displays of client systems as claimed functionally affected by displaying the number 3000? In our view, given what is claimed, we find the claim limitation "aggregate

quotes" does not have a functional relationship with the server and displays. We see no difference between this and "the situation of a merely storing in digital form, a song which clearly has no functional content per se" (Request 6). Accordingly, as we stated, "[p]atentable weight need not be given to descriptive material absent a functional relationship between the descriptive material and the substrate (here the computer system and/or display)." Decision 6. The Appellants' contentions that "the server *manages* these quotes" (Request 2, emphasis added), novel computer instructions are implicit in the claim (Request 2 and 6), and the "existence of ... an entry format for quotes" (Request 6) are unpersuasive as to error in our view because no claim language supports reading the claim more narrowly to include these limitations. To do so would improperly import limitations into the claim.

Claim 2

The Appellants argue that claim 2 "imposes upon the claimed method of managing quotes an additional functional constraint, namely, to insure that these types of received quotes are displayable on displays of client systems, and are displayed with attribution to the particular market participant." Request 6. This is unpersuasive. The claim calls simply for "receiving, by the server computer system, quotes from client systems ... ." There is no mention of "managing" anything, let alone to "insure" that these types of received quotes are displayable.

Claim 3

The Appellants challenge the Board's affirmance of the rejection of claim 3 for the same reasons used to challenge the Board's affirmance of the rejection of claim 1. Request 7. Having found the reasons for challenging the Board's affirmance of the rejection of claim 1 unpersuasive, we find the same for claim 3.

Claims 4-7

The Appellants disagree with the Board's addressing of claims 4-7 as a group and using claim 4 as representative of the group. Request 7-8. According to the Appellants these claims were argued separately in the Appeal Brief. We disagree. The heading very clearly says "Claims 4, 5, 6, and 7" and the discussion refers to them as a "group." Appeal Brief 18. See 37 CFR §41.37(c)(1)(vii). Furthermore, claims 4 and 5 were addressed together, claim 6 is not mentioned, and claim 7 is discussed with reference to Gutterman Fig. 2b as was done for claim 4. Appeal Brief 18-19. It should also be pointed out that the Appellants had not specifically addressed the Examiner's basis for rejecting any of these claims. For claim 6, for example, the Examiner relied on Figs. 5 and 6 and pages 23-24 of Gutterman, not Fig. 2b. *See* Answer 5-6. Rather, the Appellants argued over the claim 4 limitation "total aggregate quote size," and then explained in what way claims 5-7 "further limit[]" claim 4 and thus further distinguish from Gutterman. Appeal Brief 18-19.

Claims 8-9

The Appellants argue that "Gutterman does not include a total aggregate quote size." Request 9. This was addressed in the Decision. *See* Decision 8. The Appellants appear to rely on the reasons used to challenge the Board's affirmance of the rejection of claim 1. Having found those reasons unpersuasive, we find the same in challenging the Board's affirmance of the rejection of claims 8-9.

Claim 12

The Appellants rely on the reasons used to challenge the Board's affirmance of the rejection of claim 1. Request 9 ("for reasons given above"). Having found those reasons unpersuasive, we find the same in challenging the Board's affirmance of the rejection of claim 12.

Claims 13, 14, and 17

The Appellants rely on the reasons used to challenge the Board's affirmance of the rejection of claim 1. Request 10 ("for reasons given above"). Having found those reasons unpersuasive, we find the same in challenging the Board's affirmance of the rejection of claims 13, 14, and 17.

Claim 15

The Appellants rely on the reasons used to challenge the Board's affirmance of the rejection of claim 1. Request 10 ("for reasons given above"). Having found those reasons unpersuasive, we find the same in challenging the Board's affirmance of the rejection of claim 15.

Claims 18 and 19

The Appellants rely on the reasons used to challenge the Board's affirmance of the rejection of claim 1. Request 11 ("for reasons given above"). Having found those reasons unpersuasive, we find the same in challenging the Board's affirmance of the rejection of claims 18-19.

Claims 20-23

The Appellants rely on the reasons used to challenge the Board's affirmance of the rejection of claim 1. Request 11 ("for reasons given above"). Having found those reasons unpersuasive, we find the same in challenging the Board's affirmance of the rejection of claims 20-23.

CONCLUSION

We have carefully considered the arguments that the Appellants have set forth in the Request but, for the foregoing reasons, we do not find them persuasive as to error in the decision to affirm the rejection under 35 U.S.C. §102(b).

DENIED

mls

FISH & RICHARDSON P.C. (BO)
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022